

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Smith, et al.

Serial No. 10/575,117

International Application No. PCT/GB04/04328

Filed: 10/11/2004

For: EXTENDIBLE MAST

Attorney Docket No: 3174.00017

**Renewed Petition Under 37 CFR 1.47(a) to Accept Declaration with
Unavailable Inventor**

MAIL STOP PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Notice of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office dated March 1, 2007, and further in response to the Decision on Petition dated October 11, 2007. Applicants respectfully requests that the Declaration be entered with this Petition based on the Statement of Facts below. Applicants hereby petition for a five-month extension of time within which to respond to the outstanding Decision on Petition. Granting the petition would extend the time for filing the Response to May 11, 2008. The appropriate petition fee of \$1,115 is enclosed herewith.

Statement of Facts:

Kohn & Associates (law firm) sent a letter dated April 13, 2006 (Exhibit A) to Rachel Wallis at Withers & Rogers (associate law firm in the United Kingdom)

enclosing a Declaration and Assignment forms for the inventors Alan Smith and Peter O'Toole to sign and return as soon as possible, and notified Ms. Wallis that the USPTO will require submission of the Declaration in approximately two months.

Ms. Wallis sent a letter dated May 11, 2006 (Exhibit B) back to Kohn & Associates enclosing the declaration and assignment forms signed by Peter O'Toole, as well as a previous assignment signed in 2003 by Alan Smith. Ms. Wallis stated that the client (Janile Limited) was no longer able to contact their employee Alan Smith. Conversations were had between Kohn & Associates and Ms. Wallis, and it was decided that Ms. Wallis would look into the reasons why Alan Smith could not be located.

Kohn & Associates received the above referenced Notice (Exhibit C) on March 5, 2007. After the Notice was received, attorney Amy Rinaldo of Kohn & Associates was handling the matter, and left the firm in May 2007. Sheryl Fox, an administrator with Kohn & Associates, went through Ms. Rinaldo's files after her departure and found that the Notice was due without extension on May 1, 2007 and promptly emailed Ms. Wallis on May 14, 2007 (Exhibit D) that Kohn & Associates were still awaiting Alan Smith's signature. Ms. Wallis replied by email (Exhibit D) that she was still trying to get a response from Alan Smith by way of the client Janile Limited. Ms. Fox sent follow-up emails dated July 11, 2007; August 6, 2007; and September 28, 2007 (Exhibit E) prior to the final extension date of October 1, 2007.

Telephonic discussions took place between Kohn & Associates and Ms. Wallis on October 1, 2007. Ms. Wallis stated that despite regular requests for the location of Alan Smith and any updated contact information in order to obtain his signature from both Janile Limited and co-inventor Peter O'Toole, and contacting his last known address (Janile Limited, Peter O'Toole, and Ms. Wallis had contacted the last known address), no further information could be obtained regarding Alan Smith. Janile Limited had stated that Alan Smith had, since the signing of the Assignment in 2003, retired from the company, moved, and had left no forwarding address. Janile Limited was not able to find a current address

for Alan Smith. Ms. Wallis also attempted to find a current address for Alan Smith but was unsuccessful. Kohn & Associates and Ms. Wallis decided that this petition should be filed to accept the Declaration with the signature of Peter O'Toole since Alan Smith is unavailable for a signature, as October 1, 2007 is the last date of the fifth month extension in which a Declaration could be filed without irreparable damage to the parties by abandonment of the application. After receiving the Decision on Petition dated October 11, 2007, Ms. Wallis has since tried to locate Alan Smith with a current address, and since no further information was obtained, this Renewed Petition was submitted on May 12, 2008 (May 11, 2008 is a Sunday), which is the last date of the fifth month extension in which a Renewed Petition could be filed without irreparable damage to the parties by abandonment of the application.

Alan Smith's last known address, as listed on the Declaration, was:

Thornegrove and Aljon Engineering
108-118 Wellington Road
Forest Gate
London E7 8BDU England
United Kingdom

Summary of Timeline

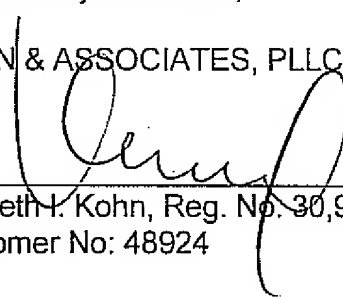
4/13/2006	Declaration and Assignment prepared and mailed to Withers & Rogers
5/06/2006	Ms. Wallis of Withers & Rogers returns Declaration and Assignment with only signature of Peter O'Toole
5/06/2006 onward	Ms. Wallis repeatedly tries to find contact information for co-inventor Alan Smith
3/05/2007	Notice of Missing Requirements received by Kohn & Associates

5/14/2007	Ms. Fox emails Ms. Wallis requesting Alan Smith's signature
5/14/2007	Ms. Wallis replies she is still trying to find contact info
7/11/2007	Follow-up email by Ms. Fox to Ms. Wallis
8/06/2007	Follow-up email by Ms. Fox to Ms. Wallis
9/28/2007	Follow-up email by Ms. Fox to Ms. Wallis
10/01/2007	Discussions between Kohn & Associates and Ms. Wallis regarding unavailability of Alan Smith and decision to make petition
10/11/2007	Decision on Petition
5/12/08	Ms. Wallis instructs Kohn & Associates to prepare Renewed Petition since no further contact has been established with Alan Smith

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



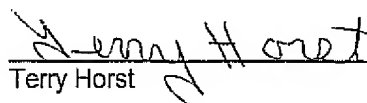
Kenneth I. Kohn, Reg. No. 30,955
Customer No: 48924

Dated: May 12, 2008

CERTIFICATE OF ELECTRONIC FILING VIA EFS-WEB

Date of Electronic Filing: May 12, 2008

I hereby certify that this correspondence is being electronically filed with the United States Patent & Trademark Office on the above date.



Terry Horst

KOHN &
ASSOCIATES
P • L • L • C
Intellectual Property Law

if any, is confidential and/or privileged and intended only for the use of the individual or entity named herein. If you have received this communication in error, please contact us immediately and return the original message to us. Any use, dissemination, distribution or copying of this communication is prohibited.

CONFIRMATION ☒ via mail
☐ via courier
☐ will not follow

April 13, 2006

KENNETH I. KOHN, Ph.D.
DEBORAH J. BARNETT, M.S.¹
¹admitted in New York
AMY E. RINALDO

Of Counsel
WILLIAM H. HORTON
LINDA M. WATSON

011-44-20-7663-3550

Rachel Wallis
Withers & Rogers
Goldings House
2 Hays Lane
London SE1 2HW
UNITED KINGDOM

Re: New United States National Phase Patent Application
Claiming priority to International Application
PCT/GB04/004328, filed 11 October 2004
For: EXTENDIBLE MAST - Smith, et al.
Our File No.: 3174.00017

Dear Rachel:

We prepared and filed the above-identified national phase patent application in the United States Patent Office, April 7, 2006, which included filing a preliminary amendment. A copy of the application as filed is enclosed for the integrity of your files.

Also, enclosed herewith are Declaration and Assignment forms for the signature of the inventors. Please return the executed documents to us as soon as possible. The United States Patent Office will require submission of the Declaration in approximately two months.

Please be advised that under United States patent law, we have a duty to disclose to the United States Patent and Trademark Office any patents, publications or other materials that are relevant to the above-identified application. If you are aware of any such materials, please forward them to us immediately for filing with an Information Disclosure Statement. If the Information Disclosure Statement is filed after receipt of a first Office Action on the merits, we must pay a surcharge. We expect a first action to be within the next 12-14 months. If we do not hear from you by **July 10, 2006**, we will assume that there are no materials to be submitted in an Information Disclosure Statement at this time. However, keep in mind that our duty of disclosure continues throughout the prosecution of this application.

30500 Northwestern Highway • Suite 410 • Farmington Hills, Michigan 48334-3179 USA
Phone: +1-248-539-5050 • Fax: +1-248-539-5055 • E-mail: kohn@kohnonline.com
Please visit our website: www.kohnandassociates.com

If you have any questions regarding the above, please do not hesitate to contact me. In the meantime, enclosed please find our Debit Note.

Very truly yours,

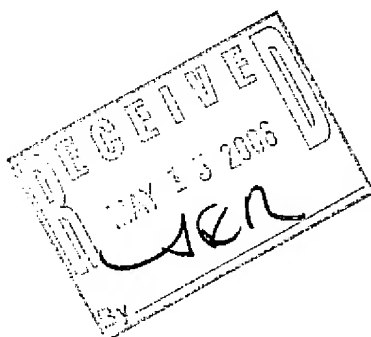
KOHN & ASSOCIATES, PLLC

A handwritten signature in black ink, appearing to be 'K. Kohn', written over a horizontal line.

Kenneth I. Kohn

KIK/ch
Enc.

Dr Kenneth I Kohn
Kohn & Associates
30500 Northwestern Hwy
Suite 410
Farmington Hills
Michigan
48334-3179
United States of America



Our Ref: P511580US-PCT/NRW/lh

Your Ref:

11 May 2006

BY COURIER

10/575,117

Dear Ken

**New US Patent Application
based on International Patent Application No. PCT/GB04/004328
Extendible Mast
Janile Limited**

Please find enclosed the declaration and assignment forms for this application signed by one of the inventors, Peter O'Toole. I also enclose an assignment that was prepared before the UK application from which this application claims priority was filed. That assignment is signed by the second inventor, Alan Smith, on behalf of his company, Thornegrove & Aljon Engineering. Unfortunately, the applicant is no longer able to contact Alan Smith. Will it be possible to proceed based on the documents enclosed, or will it be necessary to obtain a further signature from Alan Smith?

I look forward to hearing from you.

Best regards.

Yours sincerely

**Rachel Wallis
WITHERS & ROGERS LLP**

Encs

Declaration and assignment forms

Rel. 7 (2006) LLP

Partners: David Bannerman, Michael Blatchford (Chairman), Adrian Chentle, Jeff Hogg, John Dean, Ben Dempster, Karl Barnfather, Simon Beck, Howard Wright, John Jones, Fiona McBride*, David Elsy, Ivor Harrison, David Pratt, Mark Armitage*, Colin Jones, David Croston, Adrian Tombling, Laurel McBray*, James Gray, Callum Wardle, Matthew Gillard, Jim Ribeiro, Nicholas Wallin, Nicholas Jones, Withers & Rogers Group LLP
* MITMA. All other partners CPA & EPA.

Associates: Russell Barton, Rachel Wallis, Kathryn Cruse, Paul Foot, Keith Tart, Andrew Thompson, Rhiannon Turner, Matthew Allen, David McWilliams, Shelley Lunn, Rachel Williams, Marisa Foster, Chris McDonald

Translations: Rosemary Booth, **EP Formalities:** Karen Austen

Practice Director: Nick Dougan, **Financial Controller:** Ian Smith, **HR & Admin:** Sonia Greaves

Withers & Rogers LLP is a limited liability partnership registered in England and Wales (registered number OC310992) with its principal place of business and registered office at Goldings House, 2 Hays Lane, London, SE1 2HW

Also at 1 Redcliff Street, Bristol BS1 6NP Tel: +44 (0)117 925 3030 Fax: +44 (0)117 925 3530
60 Holly Walk, Leamington Spa, Warwickshire CV32 4JE Tel: +44 (0)1926 336111 Fax: +44 (0)1926 335519 and
75 Colmore Row, Birmingham B3 2AP Tel: +44 (0)121 245 3900 Fax: +44 (0)121 245 3930



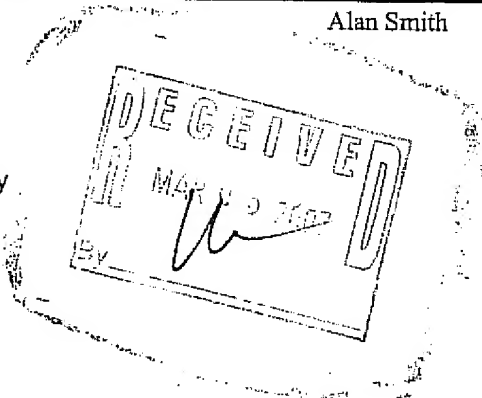
UNITED STATES PATENT AND TRADEMARK OFFICE

5-1-07

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/575,117	Alan Smith	317400017

Kenneth I. Kohn
Kohn & Associates
30500 Northwestern Highway
Suite 410
Farmington Hills, MI 48334



INTERNATIONAL APPLICATION NO.	
PCT/GB04/04328	
I.A. FILING DATE	PRIORITY DATE
10/11/2004	10/09/2003

CONFIRMATION NO. 9263
371 FORMALITIES LETTER



OC000000022699125

Date Mailed: 03/01/2007

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Indication of Small Entity Status
- Copy of the International Application filed on 04/07/2006
- Copy of the International Search Report filed on 04/07/2006
- Preliminary Amendments filed on 04/07/2006
- Oath or Declaration filed on 04/07/2006
- Request for Immediate Examination filed on 04/07/2006
- U.S. Basic National Fees filed on 04/07/2006
- Priority Documents filed on 04/07/2006
- Specification filed on 04/07/2006
- Claims filed on 04/07/2006
- Abstracts filed on 04/07/2006
- Drawings filed on 04/07/2006

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
 - is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.
<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

PAULETTE R KIDWELL



Telephone: (703) 308-9140 EXT 216

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/575,117	PCT/GB04/04328	317400017



Message

From:  Sheryl Fox
Subject: Re(2): US 10/575,117 Y/R P511580USPCT O/F 3174-17
To:  Rachel Wallis <rwallis@withersrogers.com>

Cc:

Thanks, Rachel!

Rachel Wallis <rwallis@withersrogers.com> on Monday, May 14, 2007 at 10:25 AM +0000 wrote:

Thanks Sheryl. I was aware of this, and am trying to get a response from the client.

If there is anything we can do to assist following Amy's departure, please let me know.

Best regards

Rachel

Rachel Wallis
Withers & Rogers LLP
t: 44 (0) 207 663 3500
f: 44 (0) 207 663 3550

"Sheryl Fox"
<sfox@kohnonline.
com>

Reply To

14/05/2007 15:09

To

rwallis@withersrogers.com

cc

Subject

US 10/575,117 Y/R P511580USPCT
O/F 3174-17

Hello Rachel,

I'm sure you've heard by now that Amy is no longer with our office. While going through files on her desk, the above appears to be awaiting communication from you with regard to inability to locate and/or obtain signature from co-inventor Alan Smith. If you would, please provide me with an update on the same so that I can docket our records accordingly for follow-up to you.




Also, just so you are aware, the formalities for the Declaration were timely due without surcharge May 1, 2007. Extensions with surcharges (at small entity rates) are available as follows:

June 1, 2007	\$60
July 1, 2007	\$225
August 1, 2007	\$510
September 1, 2007	\$795
October 1, 2007	\$1,080 (abandoned effective October 2, 2007, if not filed, but reinstatement may be available)


If you have any questions, please don't hesitate to let me know.

Kind regards,
Sheryl

-----Sheryl

From:  Sheryl Fox 
Subject: USSN 10/575,117 Y/R P511580USPCT O/F 3174-18
To:  Rachel Wallis
Cc:



Attachments:  3174-17 FINAL DEADLINE NOTICE.pdf

46K

Hi Rachel,

The final deadline for responding to the Notice of Missing Parts re Alan Smith's signature (lack thereof) on Dec is Monday, October 1, 2007.




Please confirm your receipt hereof and advise how/if we are to proceed.

Kind regards,
Sheryl

Sheryl M. Fox
Office Administrator
KOHN & ASSOCIATES, PLLC
30500 Northwestern Highway, Suite 410
Farmington Hills, MI 48334-3179 USA
Direct Dial: +1-248-539-5066
Fax: +1-248-539-5055
URL: www.kohnandassociates.com
E-mail: sfox@kohnonline.com

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From:  Sheryl Fox 
Subject: USSN 10/575,117 Y/R P511580USPCT O/F 3174-17
To:  Rachel Wallis
Cc:

9-28-07

REMINDER: August 6, 2007

Final Deadline

----- Original Message -----

Oct 1, 2007

Hi Rachel,

then case is

Following up with regard to the status of signature for Alan Smith re the above matter.

abandoned -



Thanks,
Sheryl

PLEASE.

confirm.

Sheryl M. Fox
Office Administrator
KOHN & ASSOCIATES, PLLC
30500 Northwestern Highway, Suite 410
Farmington Hills, MI 48334-3179 USA
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From:  Sheryl Fox 



Subject: USSN 10/575,117 Y/R P511580USPCT O/F 3174-17

To:  Rachel Wallis

Cc:

Hi Rachel,

Following up with regard to the status of signature for Alan Smith re the above matter.

Thanks,
Sheryl

Sheryl M. Fox
Office Administrator
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Farmington Hills, MI 48334-3179 USA
Direct Dial: +1-248-539-5066
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